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09/086,138 05/28/98 JAFFE

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EXAMINER

GITOMER, R

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 22

Serial Number: 09/086,138
Filing Date: May 28, 1998
Appellant(s): Robert L. Jaffe

Date mailed 2/16/01

Nancy J. Parsons
For Appellant

EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed October 26, 2000.

(1) Real Party in Interest

5 A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

10 A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

15 This appeal involves claims 1-15.

(4) Status of Amendments After Final

20 The appellant's statement of the status of amendments after final rejection contained in the brief is substantially correct. The amendments after final received 4/20/00 and 10/26/00 have not been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

5 Appellant's brief includes a statement that claims 1-15 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

10 The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,387,508 JAFFE 2-1995

15 **(10) New Prior Art**

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the
appealed claims:

5 The nonstatutory double patenting rejection is based on a
judicially created doctrine grounded in public policy (a policy
reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by
10 a patent and to prevent possible harassment by multiple
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);
In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re*
Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

15 A timely filed terminal disclaimer in compliance with 37
CFR 1.321(c) may be used to overcome an actual or provisional
rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be
commonly owned with this application. See 37 CFR 1.130(b).

20 Effective January 1, 1994, a registered attorney or agent of
record may sign a terminal disclaimer. A terminal disclaimer
signed by the assignee must fully comply with 37 CFR 3.73(b).

 Claims 1-15 stand rejected under the judicially created
doctrine of obviousness-type double patenting as being

25 unpatentable over claims 1-17 of U.S. Patent No. 5,387,508.

 Although the conflicting claims are not identical, they are not
patentably distinct from each other because the claims of '508 do
not include nor exclude any dilution or concentration of the
sample prior to testing.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe.

Jaffe (5,387,508) by the present inventor entitled "Detection of Cytotoxic Agents Using Tetramitus Rostratus" teaches in column 3 first paragraph, the sample may be a liquid, gaseous or solid material. Various types of whole effluent samples are taught.

It is noted the present specification on page 2 last paragraph discusses '508 where '508 does not disclose a WET test in which all of the potentially toxic substances from the sample are evaluated in a natural combination. See in '508 Example 5 in column 6 where a WET sample is tested. See the claims.

The claims differ from Jaffe in that they recite other flagellates than those taught by Jaffe.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ flagellates other than T. Rostratus because in view of the teachings of Jaffe, one would have a high expectation of success in employing any known flagellate with the requisite qualities taught in the present specification. It is noted that the present specification teaches specific methods and examples only for T rostratus.

Further, the present claims recite the sample is combined with the culture directly.

In `508 column 3 first paragraph, samples may be concentrated, or, in the case of solids, suspended in a liquid, prior to testing. It would appear the sensitivity of the test would be dependent upon the concentration of the cytotoxic substances and to dilute or concentrate samples to make them more suitable for a given test is well known in this art and taught by `508, see column 7 Table 2.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

(13) Response to argument

Appellant argues that the present claims require the whole effluent sample is combined directly with the culture which means there is no requirement for concentration of the sample prior to combining it with the culture. Examples 5 and 6 of Jaffe are not WET tests because a toxic substance is added to the sample. To suggest that Jaffe teaches concentration of the sample is optional does not extrapolate to a WET test. Only hindsight in view of Jaffe would teach a WET test. Jaffe does not teach any flagellates other than *T. rostratus*. The limitations of claims 7 and 11 have not been addressed. A Declaration by the inventor is presented which states the EPA definition of WET test and Examples 5 of Jaffe is not a WET test because it was contrived to evaluate the flagellates adaptation and immunity abilities.

It is the examiner's position that the specification and claims of '508 consider the feature of concentrating the sample optional, see discussion presented above. In example 5 of Jaffe, the sample is fumes from a rubber stamp manufacturer and no concentration of the fumes is recited. Jaffe teaches conclusions of the results of Example 5 as ¶An inexpensive identification procedure would then be possible prior to costly qualitative/quantitative analyses.¶ This would appear to mean the test was contrived to be an effective analysis.

It is noted in present claim 1(a) the step is obtaining a sample for testing suspected of containing a plurality of potentially cytotoxic substances is not limited to any particular type of sample. For example, the sample could be a concentrated sample which would accomplish the function stated in the preamble. No other limitations are presented regarding the type of sample or its concentration in the claims. Therefore, the present claims read on a concentrated sample as taught by Jaffe. The present specification teaches in page 9 for example, various dilutions of sample are required to obtain the desired information which includes both dilution and concentration.

Appellants are reminded that the invention is the subject matter defined by the claims, and the limitations of the specification are not read into the claims where no express statement of that limitation is included in the claims, see *In re Priest*, 199 USPQ 11.

The Appellant's remarks with regard to the Examiner's use of improper hindsight have been noted but the reference clearly shows the claims rendered obvious for reasons discussed above. The fact that the Applicants have selected specific teachings from this reference is still deemed obvious. At the time this invention was made the teachings of the reference was clearly in the public domain and one of ordinary skill in this art knowing of this reference could have selected as the Applicants have done.

Regarding the selection of a specific flagellate such as in present claims 3 and 6, the present specification appears to enabling for T. rostratus. See the present specification on page 4 second paragraph which is confusing regarding the question mark in line 12 and suggesting Tetramitus is unsuitable for marine water samples but none are taught. No advantage of any other flagellate is specifically taught and an undisclosed advantage is given little or no weight. All the functions of the present claims are taught by the present specification for only T. rostratus.

Regarding the limitations of claim 7 directed to filtering (which reads on concentrating), and claim 11 directed to particulates, Jaffe teaches concentrating particulates in column 7 Example 8, and filtering is a known method of concentrating particulates.

Appellant further argues the rejection under obviousness double patenting is unfair and redundant.

It is the examiner's position that all applicable rejections must be made as is proper.

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Art Unit 1623

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For the above reasons, it is believed that the rejections
should be sustained.

Respectfully submitted,

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